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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,991	12/06/2001	Yuuji Saiki	020606	3509
38834	7590	06/22/2006	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			LAVARIAS, ARNEL C	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/015,991	<b>Applicant(s)</b> SAIKI ET AL.	
	<b>Examiner</b> Arnel C. Lavarias	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/26/06, 2/2/06, 1/26/06.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9, 10, 17-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-10, 27-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submissions filed on 2/2/06 and 4/26/06 have been entered.

### ***Response to Amendment***

2. The amendments to Claim 1 in the submission dated 4/26/06 are acknowledged and accepted.
3. The cancellation of Claims 5-8, 13, 16, 30-35 in the submission dated 4/26/06 is acknowledged and accepted.

### ***Response to Arguments***

4. The Applicants argue that, with respect to newly amended Claim 1, as well as Claims 2-4, 9-10, 27-28, 32 which depend on Claim 1, Nagahama et al., and more specifically Arakawa et al., fail to teach or reasonably suggest a transparent protective film having an outer surface roughness Ra of 0.03 to 1 micron that does not substantially alter the transparent properties of the protective film. After reviewing Nagahama et al. and

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Arakawa et al., the Examiner agrees, and respectfully withdraws the rejections in Sections 8-9 of the Office Action dated 11/7/05.

5. Claims 1-4, 9-10, 27-28 are now rejected as follows.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 9-10, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. (WO00/44841), of record, in view of Sumi '363 (WO01/25363 A1).

It is noted that U.S. Patent No. 6582789 (Sumi '789) is the national stage published patent document based on the above WO01/25363 A1 international application.

Nagahama et al. discloses an optical member (See Figure 7) in which a surface of an optical material (See 15, 16 in Figure 7) is bonded to and covered with a protective film (See 11, 12 or 14, 11 in Figure 7), wherein the protective film comprises a protective base and an adhesive layer disposed on the protective base so that the protective base can be released together with the adhesive layer from the optical material (See Abstract; 11, 12 or 11, 14 in Figure 7). Nagahama et al. additionally discloses the protective film being disposed on one surface of the optical material (See for example 11, 12 in Figure 7), a separator being provided on an adhesive layer disposed on the other surface of the optical

material (See 11, 14 in Figure 7) so that the separator can be released from the adhesive layer (See 17 in Figure 7), the optical material comprising a polarizing plate (See 16 in Figure 7), a liquid display having the optical member (See Abstract); the protective film thickness not being more than 300  $\mu\text{m}$  (See for example Page 7 (Page 14 of translation of Nagahama et al.), as well as various disclosed examples of the protective film on Pages 17-27 (Pages 31-47 of the translation of Nagahama et al.)); and the protective film being a light-transmitting protective film (See Abstract; various examples disclosed).

Nagahama et al. lacks the protective film being transparent and having an outer surface roughness Ra of from 0.03 to 1  $\mu\text{m}$  that does not substantially alter the transparent properties of the protective film. However, Sumi '363 teaches a conventional surface protecting film and laminate for use in liquid crystal displays (See for example Abstract of Sumi '363). In particular, Sumi '363 teaches that the surface protective film includes a highly transparent substrate, such as a polyester film, and an adhesive layer (See Page 1, lines 6-10; Page 3, line 9-Page 4, line 3 of Sumi '363; col. 1, lines 7-14; col. 2, lines 35-67 of Sumi '789). Further, Sumi '363 teaches that an outer surface of the surface protective film may include a surface roughness Ra of 0.002-0.5 micron so as not to noticeably decrease the transparency of the surface protective film (See Page 6, lines 3-8 of Sumi '363; col. 4, lines 19-29 of Sumi '789). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the protective film of Nagahama et al., be transparent and have an outer surface roughness Ra of from 0.03 to 1  $\mu\text{m}$  that does not substantially alter the transparent properties of the protective film, as taught by Sumi '363, to ease or simplify inspection of the underlying attached

optical material (e.g. a polarizer element) while allowing for reasonable uniform adhesion of the adhesive layer to the surface protective film.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagahama et al. in view of Sumi '363 as applied to Claim 1 above, and further in view of Iwata et al. (U.S. Patent No. 6111699), of record.

Nagahama et al. in view of Sumi '363 discloses the invention as set forth above in Claim 1, except for the optical material further including at least one of a retardation plate and a brightness enhancement plate. However, Iwata et al. discloses an optical member (See for example Figures 6B, 7, 11) in which an adhesive layer (See 34 of Figure 6B) disposed on an outermost surface of an optical material (See 12 in Figure 6B) is provisionally bonded to and covered with a separator (See 36 in Figure 6B). Iwata et al. additionally discloses the separator being disposed on one surface of the optical material (See Figures 6B, 7), a protective film being provided on the other surface of the optical material (See 18, 32 in Figures 6B) having an outer surface roughness Ra of at least 0.03  $\mu\text{m}$  (See Abstract; col. 5, lines 50-65), the optical material comprising a polarizing plate and at least one of a retardation plate and a brightness enhancement plate (See for example 42 in Figure 7; 42, 86 in Figure 11), and a liquid crystal display having the optical member (See for example col. 10, line 25-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the optical material further include at least one of a retardation plate and a brightness enhancement plate, as taught by Iwata et al., in the optical member of Nagahama et al. in

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view of Sumi '363, for the purpose of reducing the cost and complexity of manufacturing the liquid crystal display panel.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6582789 (Sumi '789)

U.S. Patent No. 6582789 (Sumi '789) is the national stage published patent document based on the WO01/25363 A1 international application.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arnel C. Lavarias  
Patent Examiner  
Group Art Unit 2872  
6/15/06